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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/633,769	08/04/2003	Junichi Minamino	YAMAP0881US	6490

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EXAMINER

PATEL, GAUTAM

ART UNIT	PAPER NUMBER
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2627

DATE MAILED: 08/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/633,769	Applicant(s) MINAMINO ET AL.	
	Examiner Gautam R. Patel	Art Unit 2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment/Arguments:

1. This is in response to amendment filed on 7/21/06.
2. Claims 1-xx remain for examination.

Claim Rejections - 35 U.S.C. § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter.

Claim 8 does not define what is being claimed but simply states what a recording medium has.

It is still not even clear if claim pertains to **an apparatus or a method** as such.

When nonfunctional descriptive material is recorded on some computer-readable medium, in computer or an electromagnetic carrier signal, it is **non statutory** since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material. i.e. abstract idea, stored in a computer-readable medium, in a computer or on an electromagnetic carrier signal does not make it statutory. See Diehr, 45 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract idea because "[t]he sole practical application of the algorithm was in connection with programming of a general purpose computer.").

Claim 14 has the same problem as above.

NOTE: In this case all we have is a recordable medium which has data arranged on it. All mediums have kind of data arranged on it, details of this arranged data does not make it patentable as such.

Claim Rejections - 35 U.S.C. § 112

4. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-6 are rejected under 35 U.S.C. 112 first paragraph, as containing subject matter which was not described in the specification in such way as to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Specification does not explain how modulation rule [which is state-type rule] or it uses a digital sum value. And even if modulation rule uses a digital sum value what it ahs do with it being state-type modulation rule or not being a stat-type modulation rule. In other words what is the relationship with these two things.

Claim Rejections - 35 U.S.C. § 112

5. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 are confusing now because it not clear at all how “state-type modulation rule” and “a digital sum value” are equivalent and one can be replaced with another. Specification does not explain this at all.

Claim 3 has the similar problem.

Claim 8, lines 1-5 are confusing and unclear. It is not clear at all what is being claimed here. Claim in neither an apparatus nor a method, it simply states medium having some data on it. All mediums inherently has some data on it.

As to claim 14 it is not clear at all if it a an apparatus claim or a method claim. Claim does not clearly set forth the metes and bounds of the patent protection desired.

Claim Rejections - 35 U.S.C. § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-13 are rejected under 35 U.S.C. § 102(b) as being anticipated by Tanoue et al., US. patent 6,128,260 (hereafter Tanoue).

As to claim 9, Tanoue discloses the invention as claimed [see Figs. 1, 6-7] including a data modulation section, a parameter value changing section and a recording section, comprising:

7. The aforementioned claim 9, recites the following elements, inter alia, disclosed in Tanoue:

a parameter value changing section [fig. 6, unit 38] for changing a parameter value representing a target value of an offset amount of a data recording position from a prescribed reference position [col. 13, lines 19-29 & col. 15, lines 8-38];

an offset amount changing section [gap field control] for changing the offset amount of the data recording position from the prescribed reference position such that as data recording proceeds, the offset amount of the data recording position from the prescribed reference position approaches the target value [col. 4, lines 41-64 & col. 11, lines 24-60]; and

a recording section [fig. 6, unit 5] for recording the data on the recording medium at the data recording position [col. 11, lines 26-60].

8. As to claims 10-12, they are system claims corresponding to claims 4-6 respectively and they are therefore rejected for the similar reasons set forth in the rejection of claims 4-6 respectively, above.

9. The aforementioned claim 10, recites the following elements, inter alia, disclosed in Tanoue:

the parameter value changing section changes the at least one parameter value randomly [col. 15, lines 8-38].

10. The aforementioned claim 11, recites the following elements, inter alia, disclosed in Tanoue:

the parameter value changing section changes the at least one parameter value in a prescribed order [col. 15, lines 8-38].

NOTE: moment parameter is in a prescribed order.

11. The aforementioned claim 12, recites the following elements, inter alia, disclosed in Tanoue:

comprising a storage section [fig. 6, unit2 and unit 38] for storing a previously used parameter value, wherein the parameter value changing section randomly selects a parameter value to be set from parameter values which are different from the previously used parameter value [col. 11, lines 24-60 & col. 13, lines 30-52];

12. As to claim 13, it is drawn to a method corresponding to the apparatus of claim 9, and is therefore rejected for similar reasons set forth in the rejection of claim 9, above.

13. A search based on the best understanding of the claims has been made to find the most pertinent art, but no statement about invention will be appropriate at this time regarding the allowableness of claims 1-8 and 14 and no art rejection will be made in this office action regarding the claims 1-8 & 14, due to the speculation required to interpret the claims because of their indefiniteness under 35 U.S.C. 112, 1st and 2nd paragraphs as noted above (see In re Steele, 134 USPQ 292).

14. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new grounds of rejection. As to arguments for the rest of the claims, please see explanation below.

15. Applicant's arguments filed on 7/21/06 have been fully considered but they are not deemed to be persuasive for the following reasons.

In the REMARKS, the Applicant argues as follows:

A) That: "Regarding claims 9 and 13

However, Tanoue et al. does not teach or suggest providing an offset amount changing section for changing the offset amount of the data recording position such that as data recording

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proceeds the prescribed reference position approaches a target value [original emphasis] as recited in the claims” [page 10, paragraph 4-6; REMARKS].

FIRST: It seems there is problem of semantics here. The Applicants are correct that Tanoue does not see the word target value, however Tanoue does have a target value which he calls “predetermined value” [see col. 2, lines 46-54].

SECOND: Since Tanoue is changing the offset amount [gap field control] Tanoue inherently has an offset amount changing section.

B)That; “In particular, although Tanoue et al., may teach that the generated values of J, K and P are supplied to the modulator 14 so that recording data is modulated to record information on the basis of a sector format based on J, K and P, but this does not represent an offset amount changing section as recited in the claims.

For example, the present application describes how recording clock generation circuit 230” [page 11, paragraph 1-2; REMARKS].

FIRST: As to be what is being CLAIMED so far Tanoue discloses all the parts.

SECOND: The aspects of clock circuit etc. has not been claimed.

16. Applicant's amendment necessitated the new grounds of rejection presented in this office action. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Contact information

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gautam R. Patel whose telephone number is 571-272-7625. The examiner can normally be reached on Monday through Thursday from 7:30 to 6.

The appropriate fax number for the organization (Group 2600) where this application or proceeding is assigned is 571-273-8300.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Dwayne Bost, who can be reached on (571) 272-7023.

Any inquiry of a general nature or relating to the status of this application should be directed to the Electronic Business Center whose telephone number is 866-217-9197 or the USPTO contact Center telephone number is (800) PTO-9199.



Gautam R. Patel
Primary Examiner
Group Art Unit 2627

August 10, 2006